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Remarks

Claims 1-16, 18-24, 29-33, and 35 are pending in this application. Claims 1-12 and 18-24 have been withdrawn from consideration. Claims 13-16, 29-33, and 35 have been rejected. By this response, Applicants amend claims 13, 14, 29, and 35. Applicants respectfully request reconsideration of the rejected claims in light of the amendments and the following remarks.

Claim Amendment

Independent claims 13 and 29 have been amended to recite that the article's porosity can be either reversibly or irreversibly changed upon release from stretching by controlling the amount of stretching of the article. Support for this amendment is found, for example, on page 4, lines 19-22; page 8, line 30 through page 9, line 4; and page 16, line 27 through page 17, line 3 of the present specification. No new matter is added by this amendment.

§103 Rejection of claims 13-15, 31, and 35 as being unpatentable over Lindquist

Claims 13-15, 31, and 35 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Lindquist et al. (U.S. Patent No. 3,665,918). Applicants respectfully traverse this rejection as applied to the amended version of the claims.

In order to establish a *prima facie* case of obviousness, the Patent Office must demonstrate that (1) there is a suggestion or motivation in the prior art to modify or combine reference teachings, (2) one skilled in the art would have had a reasonable expectation of success in making the modification or combination, and (3) the prior art reference(s) disclose all of the claim limitations. The fact that one of ordinary skill in the art would have had the capability to modify the method disclosed in the prior art reference(s) is not sufficient. MPEP 2143.01. The prior art reference(s) must provide a

motivation or reason for making the changes. MPEP 2142; *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984)

By the present Response, Applicants have amended claim 13 to recite that the porosity of the article is either reversibly or irreversibly changed depending upon the amount of stretching to which it is subjected. As explained in the present specification, one of the properties of the articles of the present invention is that one may reversibly change the porosity of the foam by stretching and relaxing the foam material as it is being used. Upon stretching, the moisture vapor transition rate ("MVTR") of the foam increases. Depending on the amount of stretching, the foam may recover all or only a predetermined portion of the increase in porosity or MVTR as desired. Lindquist does not teach or describe a foam having such properties. The Examiner has identified nothing in Lindquist that discloses this limitation.

The Examiner has previously acknowledged that "Lindquist does not specifically disclose that stretching can increase the moisture vapor transition rate of their breathable foam." (Office Action mailed 11/06/02, p. 5) The Examiner, however, has taken the position that this would be obvious because it is believed that "the moisture vapor transition rate of the breathable foam of Lindquist inherently increases when stretched." *Id.* First, Applicants note that the doctrine of inherency is inapplicable in the context of an obviousness rejection under § 103. See *In re Shetty*, 566 F.2d 81, 86 (CCPA 1977). In any event, even if the moisture vapor transition rate of the Lindquist foam would be inherently increased upon stretching, the amended version of claim 13 further recites that the foam is characterized by the property that the reversibility of the change in porosity of foam can be controlled by the amount of stretching that the article is subjected to. Even if one skilled in the art would have been motivated to stretch the Lindquist foams to increase MVTR, there is nothing in Lindquist to teach of suggest that the reversibility of the increase in porosity of the Lindquist could be controlled by controlling the amount of stretching.

For these reasons, Lindquist does not disclose all of the elements of claim 13.. Thus, Lindquist alone cannot render claim 13 obvious. The Watson reference does not provide the essential teachings lacking from Lindquist. The Office Action asserts that Watson discloses rupturing cellular membranes of polyurethane foams; however, this reference is merely cited to show the general state of the art and is not expressly relied upon by the Examiner as a basis for rejection nor does the Examiner identify any motivation for combining the teachings of Watson with those of Lindquist. In any event, Watson fails to disclose a foam having the properties recited in claim 13, i.e. a foam the porosity of which may be reversible or irreversibly increased by controlling the degree of stretching. Thus, even in combination Lindquist and Watson do not provide the present invention.

Applicants respectfully submit that the rejection of claims 13-15, 31, and 35 under 35 USC § 103(a) as obvious over Lindquist has been overcome and should be withdrawn.

§103 Rejection of claims 13-16 as being unpatentable over Walther

Claims 13-16 stand rejected under 35 USC § 103(a) as being unpatentable over Walther (U.S. Patent No. 5,905,097). Applicants respectfully traverse this rejection as applied to the amended version of the claims.

Walther fails to disclose a foamed article having porosity that can be reversibly or irreversibly changed depending upon the amount of stretching to which the article is subjected. Applicants again point out that, as with Lindquist, the Examiner has previously acknowledged that "Walther does not specifically disclose that stretching can increase the moisture vapor transition rate of their breathable foam." (Office Action mailed 11/06/02, p. 9) The Examiner nevertheless contends that this modification would be obvious because it is believed that "the moisture vapor transition rate of the breathable foam of Walther inherently increases when stretched." *Id.* As discussed above, the inherency of a claimed element or advantage of the invention is irrelevant in the context of an obviousness rejection under § 103. See *In re Shetty*, 566 F.2d 81, 86 (CCPA 1977). Moreover, even if

the MVTR of the Walther foam would inherently increase upon stretching, the amended version of claim 13 further recites that the reversibility of the increase can be controlled by controlling the amount of stretching. There is nothing in Walther to teach or suggest a foam having such a property.

Applicants respectfully submit that the rejection of claims 13-16 under 35 USC § 103(a) as being unpatentable over Walther has been overcome and should be withdrawn.

§103 Rejection of claims 29, 30, 32, and 33 as being unpatentable over Lindquist in view of Pufahl

Claims 29, 30, 32, and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lindquist (U.S. Patent No. 3,665,918) in view of Pufahl (U.S. Patent No. 4,169,184). Applicants respectfully traverse this rejection as applied to the amended version of the claims.

Claim 29 has been amended in a similar manner as claim 13 and thus now recites that the porosity of the foam layer is either reversibly or irreversibly changed depending on the amount of stretching. Consequently, for the reasons discussed above, Lindquist alone does not establish a *prima facie* case of obviousness, because Lindquist does not teach or suggest increasing the porosity of the foams by stretching nor does Lindquist describe a foam in which the reversibility of the increase in porosity can be controlled by controlling the amount of stretching. Pufahl does not cure these deficiencies. Pufahl describes a foam substrate coated with a pressure sensitive acrylic resin adhesive. Pufahl teaches that a release tape may be applied to an outer surface of the adhesive layer. There is nothing in Pufahl that teaches or suggests or provides any motivation for stretching the foam to increase porosity, and Pufahl certainly does not teach that such an increase in porosity may be reversible or irreversible depending on the amount of stretching of the article. Since Pufahl does not disclose the claim elements that are lacking from Lindquist, these references even in combination do not render the claimed invention obvious.

Conclusion

In view of the foregoing remarks, it is submitted that the application is in condition for allowance. Applicants respectfully request reconsideration of the application and allowance of claims 13-16, 29-33, and 35.

Respectfully submitted,

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